

REMARKS

The Office Action mailed February 22, 2005 has been received and carefully considered. Claims 1-20 are currently pending. Claim 18 stands rejected under 35 U.S.C. §102(b) as anticipated by U.S. Patent 5,826,244 to Huberman (Huberman). Claims 1-10, 12-17 and 20 stand rejected under 35 U.S.C. §103(a) as unpatentable over Huberman in view of U.S. Publication 2003/0140315 to Blumberg, et al. (Blumberg). Claims 11 and 19 stand rejected under 35 U.S.C. §103(a) as unpatentable over Huberman in view of Blumberg and further in view of the collection titled Kinkos.com that includes kinkos.com on February 29, 2000 and Kinkos.com on February 24, 2004.

I. Rejection under 35 U.S.C. § 102(b).

Claim 18 stands rejected as anticipated by Huberman. Applicants respectfully traverse the rejection. Specifically, Huberman is said to disclose a method and system for providing a document service over a computer network using an automated brokered auction. Office Action at page 3.

Claim 18 is directed to a method of submitting a copy reproduction order request to a copy reproduction service provider. The method comprises the steps of accessing, by a user, a copy reproduction application from a computer network, selecting, by a user, a copy reproduction service to be provided by a copy reproduction service provider using the copy reproduction application, completing, by a user, a copy reproduction order request for the selected copy reproduction service using the copy reproduction application, storing the completed copy reproduction order request in a database, the completed copy reproduction order request including at least one file having material to be copied by the copy reproduction service provider, accessing, by the copy reproduction service provider, a plurality of copy reproduction

order requests from the database using a service provider application, and downloading from the database, by the copy reproduction service provider, the at least one file having material to be copied for a copy reproduction order request selected by the copy reproduction service provider for making copies of the material to be copied.

As a threshold matter, Applicants note that Huberman is directed to a document brokerage service for providing an automated auction. In fact, even a cursory review of Huberman shows just how different are the two. Huberman goes to great lengths to describe the auction process, and then very simply states at col. 13, line 17 that “thereafter, the transaction can proceed.” That is, Huberman spends little to no time discussing the user/supplier interaction, which, at best, appears to simply presume a conventional relationship. Huberman wholly fails to appreciate or in any way teach, disclose or suggest Applicants’ claimed invention directed to a method of submitting a copy reproduction order request to a copy service provider.

Huberman fails to teach storing the complete copy reproduction order request in a database, the request including at least one file having material to be copied. A purchasing officer provides particulars such as number of copies to be printed, size and paper quality and other factors relevant to a supplier for estimating the cost of a print job. Huberman, col. 4, lines 57-65. Only after the auction is over is the service provider communicated to the customer and the substance of the job provided to the winning provider. *Id.*, col. 5, lines 9-23. Thus, Huberman fails to teach storing at least one file having material to be copied along with the order request: the order request has already been provided to the service provider prior to the file being delivered to the provider.

Huberman also fails to teach, disclose or suggest the limitation of accessing, by the copy reproduction service provider, a plurality of copy reproduction order requests. The Examiner

argues that this limitation is met because the brokerage service of Huberman multicasts the job requirements to numerous suppliers. *See* Office Action at pages 4-5. However, the brokerage service is not the service provider. Nowhere does Huberman teach, disclose or suggest that the service provider accesses a plurality of copy reproduction order requests. As discussed above, the service provider works on a single document at a time (upon winning the bid) and as such does not access a plurality of requests.

As Huberman fails to teach, disclose or suggest each and every limitation of claim 18, it cannot anticipate the invention and the rejection should be withdrawn.

II. Rejection under 35 U.S.C. § 103(a).

Claims 1-10, 12-17 and 20 stand rejected as unpatentable over Huberman in view of Blumberg. Claims 11 and 19 stand rejected as unpatentable over Huberman in view of Blumberg and further in view of Kinkos.com. Applicants respectfully traverse the rejections.

As stated by the Federal Circuit, “a proper analysis under 35 U.S.C. § 103 requires, *inter alia*, consideration of two factors: (1) whether the prior art would have suggested to those of ordinary skill in the art that they should make the claimed composition or device, or carry out the claimed process; and (2) whether the prior art would also have revealed that in so making or carrying out, those of ordinary skill would have a reasonable expectation of success.” *In re Vaeck*, 947, F.2d 488, 493 (Fed. Cir. 1991). In addition, the prior art reference(s) must teach or suggest all of the claim limitations. The teaching or suggestion to combine and the reasonable expectation of success must both be found in the prior art, and not in Applicant’s disclosure. *Id* at 493. *See also* M.P.E.P. § 2142.

A. Claims 1-10, 12-17 and 20

Claims 1 and 12 are independent. Again, Applicants note that Huberman is directed to a service for providing an auction, not for the submission and monitoring of copy reproduction requests. Huberman goes to great lengths to describe the auction process, and then very simply states at col. 13, line 17 that “thereafter, the transaction can proceed.” Huberman wholly fails to appreciate or in any way teach, disclose or suggest Applicants’ claimed invention directed to a system and a computer program for submitting and monitoring copy reproduction order requests.

Each of claims 1 and 12 includes the limitation of a database to store information on copy reproduction requests, wherein the stored information comprises order information on copy reproduction requests and status information on copy reproduction requests. Nowhere, does Huberman teach, disclose or suggest storing status information. The Examiner appears to simply rely on the fact that Huberman teaches computers, that computers typically contain a memory, and that the memory might contain order and/or status information, without pointing to any teaching or suggestion that order and/or status information is actually contained. The Examiner is requested to cite the specific portion of Huberman that teaches or suggests the claim limitation.

The present rejection is a § 103 combination rejection. It is well established that a proper § 103 combination rejection requires more than just finding teachings in the references of the elements recited in the claim (but which was not done here). To reach a proper teaching of an article or process through a combination of references, there must be stated an objective motivation to combine the teachings of the references, not a hindsight rationalization in light of the disclosure of the specification being examined. MPEP 2143 and 2143.01. *See also*, for example, *In re Fine*, 5 USPQ2d 1596, 1598 (at headnote 1) (Fed.Cir. 1988), *In re Laskowski*, 10 USPQ2d 1397, 1398 (Fed.Cir. 1989), *W.L. Gore & Associates v. Garlock, Inc.*, 220 USPQ 303,

311-313 (Fed. Cir., 1983), and *Ex parte Levengood*, 28 USPQ2d 1300 (Board of Appeals and Interferences, 1993); *Ex parte Chicago Rawhide Manufacturing Co.*, 223 USPQ 351 (Board of Appeals 1984). As stated in *In re Fine*:

The PTO has the burden under section 103 to establish a prima facie case of obviousness. [citation omitted] It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.
5 USPQ2d 1596, 1598

Following this authority, the MPEP states that the Examiner must provide such an objective basis for combining the teachings of the applied prior art. In constructing such rejections, MPEP 2143.01 provides specific instructions as to what must be shown in order to extract specific teachings from the individual references:

“Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention when there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).”

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“The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).”

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“A statement that modifications of the prior art to meet the claimed invention would have been ‘well within the ordinary skill of the art at the time the claimed invention was made’ because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd.Pat.App.& Inter. 1993).”
MPEP 2143.01

Here, there is set forth no objective basis for combining the teachings of the references in the manner used by this rejection, and selecting the helpful portions from each reference while

ignoring the unhelpful portions. An objective basis is one set forth in the art or which can be established by a declaration, not one that can be developed in light of the present disclosure. More specifically, Huberman fails to teach storing status information or even the desirability of storing such status information, much less that the status information, if stored, is made available to a user in response to a request by the user. Thus, even if Blumberg did teach that status information could be retrieved, one of ordinary skill in the art would not be motivated to combine the two nor be motivated to arrive at Applicants' claimed invention.

Claims 2-10, 13-17 and 20, depend from claims 1, 12 and 18, which are believed to be allowable in light of the foregoing remarks.

Furthermore, with respect to claims 2 and 13, each of which include the limitation that the stored information includes at least one file having material to be copied, Huberman also fails to teach, disclose or suggest this limitation as argued otherwise by the Examiner. *See* Office Action at pages 8-9, 15. At most, and as relied upon by the Examiner, Huberman teaches that after the auction is over, the "substance of the job...can be provided electronically to the supplier by the customer, either directly or through the broker..." Huberman, col. 5, lines 17-20. Yet, nothing in this broad generalization supports any teaching or suggestion that the file is stored on the same database as the stored information that includes order information and status information. Even assuming *arguendo* that Huberman teaches or suggests that the broker stores both status information and order information on a database, which, as already shown, he does not, if Huberman suggests anything with respect to the substance of the job itself, it is that the substance of the job is simply forwarded by the broker as an intermediary. The only prerequisite to holding the auction by the broker is a description of the job. *See Id.*, col. 16, lines 36-37.

As noted by the Examiner, Huberman indicates that along with the substance of the job, the supplier also passes payment information and payment terms. Thus, if Huberman teaches or suggests that the file is stored in the database, Huberman must also suggest that the payment information is stored in a database, contrary to the teaching that generally, fees for the brokerage service are invoiced to the customer for payment (col. 14, lines 43-46), which would be unnecessary if the brokerage service was already in possession of all of the necessary payment information.

Finally, Applicants find no basis for the Examiner's argument that the mere fact that the broker might provide the supplier the job electronically as sufficient to suggest the file is stored in the broker's database. In fact, this statement is no more suggestive of the Examiner's position than the opposite of the Examiner's position. This is especially true since Huberman makes no mention of the substance of the job until after the auction is complete, at which point the broker's function is already complete. Thus, there would be no reason to provide the job to the broker and save it to the broker's database, when the only need for the job at that point is for the broker to forward it to the supplier.

The Examiner's argument that providing "particulars of the job" might possibly include providing the entire file is untenable. Huberman lists specific particulars such as the size of the report to be printed and the number of copies. Certainly if Huberman had intended such a significant particular as providing the entire job itself, it would have been listed. Instead, the substance of the job is discussed later and only with respect to occurrences after the conclusion of the auction.

For at least these reasons, claims 1-10, 12-17 and 20 are all believed to be allowable and the rejection under 35 U.S.C. §103 should be withdrawn.

B. Claims 11 and 19

Claims 11 and 19 depend from claims 1 and 18 respectively. Kinkos.com fails to overcome the deficiencies of either Huberman or Blumberg. As a result, claims 11 and 19 are also believed to be allowable for at least the same reasons as already presented and this rejection should also be withdrawn.

CONCLUSION

For at least the foregoing reasons, Applicants respectfully request reconsideration of the Application and withdrawal of the outstanding rejections. Applicants respectfully submit that claims 1-20 are not anticipated nor rendered obvious by Huberman, Blumberg, Kinkos.com or their combination and thus, are in condition for allowance. As the claims are not anticipated by, nor rendered obvious in view of, the applied art, Applicants request allowance of claims 1-20 in a timely manner. If the Examiner believes that prosecution of this Application could be expedited by a telephone conference, the Examiner is encouraged to contact the Applicants' undersigned representative.

This Response has been filed within three months of the mailing date of the Office Action and it is believed that no fees are due with the filing of this paper. In the event that Applicants are mistaken in their calculations, the Commissioner is authorized to deduct any fees determined by the Patent Office to be due from the undersigned's Deposit Account No. 50-1059.

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Respectfully submitted,

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